



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/066,061    04/24/98    ZAVRACKY

M    KPN97-04A2

021005    LM12/0509  
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EXAMINER

NGUYEN, J

ART UNIT

PAPER NUMBER

2778

DATE MAILED:

05/09/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/066,061**

Applicant(s)  
**MATTHEW ZAVRACKY ET AL.**

Examiner  
**Jimmy H. Nguyen**

Group Art Unit  
**2778**



☒ Responsive to communication(s) filed on Mar 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-24 is/are pending in the application

Of the above, claim(s) 1-13 and 15-24 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 6 and 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. This Office Action is made in response to applicant's RESPONSE TO RESTRICTION REQUIREMENT AND AMENDMENT, filed 03/31/2000 (entered into the file wrapper as Paper No. 10).

#### ***Election/Restriction***

2. Claims 1-13 and 15-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, the requirement having been traversed in Paper No. 10.

Applicant's argument filed "The entire ... 34D", page 3, first and second paragraphs, has been fully reconsidered but they are not persuasive, because a search and examination of the entire application would place a serious burden on the Examiner since all species disclose the distinct inventions, i.e., species I as illustrated by figures 1-4 discloses a structure of a microdisplay, species II as illustrated by figures 5-9 discloses a process of manufacturing the microdisplay, species III as illustrated by figures 10-11 discloses a driving waveform to drive a pixel to black or red or other colors, species V as illustrated by figures 15-17 discloses a LCD with an internal heater, species XI as illustrated by figures 29A-29C discloses a structure of a memory circuit board, species XII as illustrated by figures 30A-30J discloses a structure of a

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telephone system, elected species XVII as illustrated by figures 34A-34D discloses a structure of a portable display system and etc.. Because these inventions are distinct as described above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Applicants indicate claims 1-24 readable on the elected species XVII as illustrated in figures 34A-34D. However, from the specification, page 50, line 29 - page 51, line 21, and the figures 34A-34D, Examiner does not believe claims 1-13 and 15-24 readable on the elected species XVII, since these claims include the features readable only on non-elected species, i.e., claim 1 recites "a wireless transceiver" which is not shown in figures 34A-34D, claim 15 recites "the audio transducer device" which is not shown in figures 34A-34D, claim 19 recites a method of writing an image to a LCD which is not shown in figures 34A-34D and etc.. Therefore, claims 1-13 and 15-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species.

### ***Information Disclosure Statement***

3. The information disclosure statement filed on October 16, 1998 (entered into the file wrapper as Papaer No. 5) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the

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application file, but the information referred to therein has not been considered. **In addition, the applicant fails to show how these references are pertinent to the currently filed claims.**

***Specification***

4. The disclosure is objected to because of the following informalities: page 51, line 21, "606" should be changed to --600-- to be consistent with figure 34A.

Appropriate correction is required.

***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: page 51, line 2, "housing 604", line 6, "an opening 622" and line 18, "microdisplay 638". Correction is required.
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: figure 34B, reference numbers "6" and "60". Correction is required.

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***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 1, the specification, page 50, line 29 - page 51, line 21, and the figures 34A-34D do not teach the claimed limitation "a housing having a volume of less than 330cm<sup>3</sup>", but only teach a housing 604 on page 51, line 2. Therefore, this claim is rejected for the reason as set forth above.

***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 14 is provisionally rejected under the judicially created doctrine of double patenting over claim 18 of copending Application No. 09/004,706. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

The claim of the current application recites the features which are fully recited in the copending application and does not recite additional features which are recited in the copending application. In other word, the claim of the current application is broader than the claim of the copending application.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novis et al. (USPN: 5,867,795, cited in IDS Paper No. 8).

As per claim 14, the claimed invention reads on Novis et al. as follows: Novis et al. discloses a portable display system comprising a housing (11), a LCD (20) carried by the housing, a lens (44) that manifies an image on the display and a card reader (16) within the housing that receives video input to be displayed on the display from a card (18) that docks with the card reader (figures 1 and 5, column 3, lines 25-51 and column 7, lines 40-66).

Novis et al. disloses all the subject matter claimed with the exception of the particular size of the housing and the particular operating frequency of the card reader. Absent a showing of criticality it would have been within the level of skill in the art and obvious to one having ordinary skill to engineering design the size of the housing and the operating frequency of the card reader as desired as was judicially recognized in re Rose, 105 USPO 237 (CCPA 1955).

Therefore, this claim is rejected for the reason as set forth above.



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***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422. The examiner can normally be reached on Monday thru Thursday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached on (703) 305-4938.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

(703) 308-6606 (for informal or draft communications, please label

“Proposed” or “Draft”)

Hand delivered response should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth floor (Receptionist).

JHN

05/03/2000

  
Amare Mengistu  
Primary Examiner